

REMARKS

This amendment is submitted preliminary to the issuance of an Office Action in the present application and in response to the Advisory Action of February 5, 2007.

Reconsideration of the prior rejections is hereby respectfully requested.

Claims 20-49 are pending in the application. Claims 26-29 are withdrawn from consideration and were cancelled. Claims 31-32 are cancelled. A total of 24 claims is now on file. Claims 20 and 30 were amended.

On January 3, 2007, applicant filed a request for reconsideration submitting declarations from two professionals in the field that have used the electrode according to the invention and arguing that the prior final rejection was premature in view of applicant having submitted amended claims.

In his Advisory Action dated February 5, 2007, the Examiner addressed the declarations of the two professionals. The Examiner advised that the claims should reflect more specific alloys. By amending independent claims 20 and 30, applicant has followed the advisory action.

The declarants' statements about the surgical instrument according to the invention are reflected in the currently submitted claims. Moreover, both declarants state that germanium is critical to the composition of the surgical instrument.

REJECTION UNDER 35 U.S.C. §103(a)

In order to more clearly set forth the surgical instrument according to the invention, applicant has narrowed the ranges of the compounds that are included aside from the germanium content. Support for the ranges are found on page 21 paragraph [0064] of the specification. In the four samples the germanium content ranges from 1.83% to 3.75%. Support for the lower end of the range (0.9%) as claimed is found on page 14, paragraph [0053] of the specification. The compounds of gold, indium, copper and silicon and their percentage up to 1.0% are also found in paragraph [0064] in the specification.

Applicant submits that the Schmid reference in no way renders the claimed instrument obvious. Applicant's former arguments relating to the Schmid reference are incorporated herein by reference.

The Schmid electrode is inapposite to the claimed invention. The Examiner has not shown why the person skilled in the art would consult the Schmid reference when creating a surgical instrument in which germanium is a critical ingredient.

Schmid discloses an EKG electrode. 4 sample compositions are taught by Schmid. Only one of the samples includes germanium. It is listed at 5%. Applicant states in the description that germanium must be present, i.e. showing that it is critical. Schmid does not suggest or teach that germanium is critical. The Schmid electrode does not have to include any germanium.

Furthermore and significantly, nothing in Schmid teaches those skilled in the art, that an electrode with germanium has special characteristics. Moreover, Schmid does not teach that lowering the percentage of germanium content would produce an electrode with more desirable characteristics. Clearly, germanium has no relevance in Schmid since it is not used in three of the four samples.

In their declarations Drs. Goodrich and Niamtu state that the germanium content is critical. Nothing in Schmid teaches anything about the composition as claimed. If there is any teaching in Schmid, then it is that germanium is irrelevant for the EKG electrode.

In summary, based on the amended claims, the Schmid reference has a complete different composition and Schmid shows that germanium is irrelevant to an electrode.

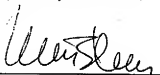
CONCLUSION

Applicant submits these amended claims to overcome the Examiner's rejection based on the Schmid reference.

In further examining this application, the Examiner should take the foregoing into account.

Respectfully submitted,

By:


Ursula B. Day
Attorney for Applicant
Reg. No. 47,296

Date: February 12, 2007
350 Fifth Avenue
Suite 4714
New York, N.Y. 10118
(212) 244-5500
UBD:ub